

REMARKS

Claims 1-3, 5-10, and 12-17 are pending and under current examination.

Applicants have amended claims 1, 9, 10, 12, 16, and 17. Support for these amendments may be found in the specification at, for example, paragraphs [0119-0125], [0127-0135], and Figs. 14-17. In addition, Applicants have cancelled claims 11 and 18, without prejudice or disclaimer.

In the Final Office Action, the Examiner took the following actions:

- (1) rejected claims 11 and 18 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement;
- (2) rejected claims 11 and 18 under 35 U.S.C. § 101, as being directed to non-statutory subject matter;
- (3) rejected claims 1-3, 5-7, and 9-18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0126994 ("*Gunji*") in view of U.S. Patent Application Publication No. 2003/0228133 ("*Nakajima*"); and
- (4) rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over *Gunji* in view of *Nakajima*, and further in view of U.S. Patent No. 6,298,173 ("*Lopresti*").

Applicants respectfully traverse the rejections in light of the foregoing amendments and the following remarks.

Information Disclosure Statement (IDS)

Applicants thank the Examiner for the consideration of IDSs filed on May 5, 2006 and October 13, 2009. However, Applicants note that the Examiner did not return the

PTO/SB/08 form associated with the Information Disclosure Statement (IDS) filed on May 5, 2006 (the Examiner only returned the first three pages of the IDS). Applicants include herein a copy of the PTO/SB/08 form filed on May 5, 2006 and respectfully request that the Examiner return the PTO/SB/08 form with appropriate notations indicating the references have been considered in the next communication.

Rejections of Claims 11 and 18 under 35 U.S.C. §§ 101 and 112, 2nd ¶

These rejections are moot due to the cancellation of claims 11 and 18.

Rejection of Claims 1-3, 5-7, and 9-18 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1-3, 5-7, 9, 10, and 12-17 under 35 U.S.C. § 103(a) as being unpatentable over *Gunji* in view of *Nakajima*. The rejection of claims 11 and 18 is moot due to their cancellation.

The Final Office Action has not properly resolved the *Graham* factual inquiries, as required to establish a framework for an objective obviousness analysis. See M.P.E.P. § 2141(II), citing to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), as reiterated by the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In particular, the Final Office Action has not properly ascertained the differences between the claimed invention and the prior art, at least because the Final Office Action has not properly interpreted the prior art and considered both the invention and the prior art as a whole. See M.P.E.P. § 2141(II)(B).

Claim 1, as amended, recites a combination including “[a] recording control means [] configured to: determine an amount of data of moving images stored in a buffer; control recording of moving images onto the data recording medium when the amount of data of moving images stored in the buffer is no less than a first

predetermined threshold, such that the moving images corresponding to a predetermined time interval are recorded in a first contiguous area of the data recording medium; after the recording of the moving images corresponding to the predetermined time interval; determine an amount of data of encoded images stored in the buffer; and control recording of encoded images onto the data recording medium when the amount of data of encoded images stored in the buffer is no less than a second predetermined threshold, such that the encoded images are recorded in a second contiguous area of the data recording medium” (emphases added).

In the Final Office Action, the Examiner acknowledged that *Gunji* fails to teach Applicants’ claimed “wherein the recording control means controls recording of the encoded image onto the data recording medium such that the encoded image is recorded in a second contiguous area of the data recording medium when the amount of data of the encoded image exceeds a predetermined threshold if the recording of the moving image in the first area of the data recording medium is ended,” as recited in claim 1 minus the amendments. See Final Office Action, page 5.

In addition, *Gunji* also fails to teach or suggest Applicants’ claimed “determine an amount of data of moving images stored in a buffer ...[and] after the recording of the moving images corresponding to the predetermined time interval; determine an amount of data of encoded images stored in the buffer,” as recited in the amended claim 1.

Nakajima does not cure the deficiencies of *Gunji*. For example, *Nakajima* discloses a recorder which “produces a thumbnail image showing well the characteristic of a moving image even if the moving image was subject[] to an effect process.” *Nakajima*, paragraph [0014]. However, in *Nakajima*’s recorder, “[a]n I/F 110 reads out

the compressed moving image data temporarily stored in the image memory 104 at predetermined timings and in the unit of predetermined amount, and stores the compressed moving image data on a hard disc (HDD) 109.” *Nakajima*, paragraph [0034]. That is, *Nakajima*’s recorder records the moving image to the hard disc at fixed, predetermined timings, regardless of the amount of data stored in the image memory 104. Therefore, *Nakajima*’s recorder cannot constitute Applicants’ claimed “determine an amount of data of moving images stored in a buffer,” and “control recording of moving images ... when the amount of data of moving images stored in the buffer is no less than a first predetermined threshold,” as recited in amended claim 1 (emphases added).

Nakajima’s recording process of thumbnails also cannot constitute Applicants’ claim 1. For example, *Nakajima* discloses that “[u]pon instruction of [] recording termination, CPU 111 instructs I/F 110 to stop recording moving image data, and outputs thumbnail image data stored in the image memory 104 to the moving image coding unit 108 ... and writes it onto the hard disc (HDD) 109.” *Nakajima*, paragraph [0039]. Therefore, *Nakajima*’s recorder writes thumbnail data to the hard disc based on the termination or stopping of recording, which is in turn determined by a user who presses a photographing button. See *Id.* Therefore, *Nakajima* also fails to teach or suggest Applicants’ claimed “after the recording of the moving images corresponding to the predetermined time interval; determine an amount of data of encoded images stored in the buffer; and control recording of encoded images onto the data recording medium when the amount of data of encoded images stored in the buffer is no less than a second predetermined threshold, such that the encoded images are

recorded in a second contiguous area of the data recording medium,” as recited in amended claim 1 (emphases added).

Thus, the Final Office Action has not properly ascertained the differences between the prior art and the claimed invention. In view of the reasoning presented above, Applicants therefore submit that independent claim 1 is not obvious over *Gunji* and *Nakajima*, whether taken alone or in combination. Claim 1 is therefore allowable over *Gunji* and *Nakajima*. Claims 9, 10, 12, 16, and 17, while of different scope, contain recitations similar to claim 1, and are also allowable. Dependent claims 2-3, 5-7, and 13-15 are allowable at least by virtue of their respective dependence from allowable independent claim 1 or 12, and because they recite additional features not taught or suggested by the cited references. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection.

Rejection of Claim 8 under 35 U.S.C. § 103(a)

Applicants request reconsideration and withdrawal of the rejection of claim 8 under 35 U.S.C. § 103(a) as being unpatentable over *Gunji* in view of *Nakajima*, and further in view of *Lopresti*.

As discussed above, *Gunji* and *Nakajima*, taken either alone or in combination, fail to disclose Applicants' claimed “[a] recording control means [] configured to: determine an amount of data of moving images stored in a buffer; control recording of moving images onto the data recording medium when the amount of data of moving images stored in the buffer is no less than a first predetermined threshold, such that the moving images corresponding to a predetermined time interval are recorded in a first contiguous area of the data recording medium; after the recording of the moving images

corresponding to the predetermined time interval; determine an amount of data of encoded images stored in the buffer; and control recording of encoded images onto the data recording medium when the amount of data of encoded images stored in the buffer is no less than a second predetermined threshold, such that the encoded images are recorded in a second contiguous area of the data recording medium,” as recited in amended claim 1 (emphases added).

Lopresti does not cure the deficiencies of *Gunji* and *Nakajima*. For example, *Lopresti* discloses “a method of managing storage in a document image database using document analysis to partition documents into logical regions.” *Lopresti*, Abstract. However, *Lopresti* also does not disclose or suggest Applicants’ claimed “[a] recording control means [] configured to: determine an amount of data of moving images stored in a buffer; control recording of moving images onto the data recording medium when the amount of data of moving images stored in the buffer is no less than a first predetermined threshold, such that the moving images corresponding to a predetermined time interval are recorded in a first contiguous area of the data recording medium; after the recording of the moving images corresponding to the predetermined time interval; determine an amount of data of encoded images stored in the buffer; and control recording of encoded images onto the data recording medium when the amount of data of encoded images stored in the buffer is no less than a second predetermined threshold, such that the encoded images are recorded in a second contiguous area of the data recording medium,” as recited in amended claim 1 (emphases added).

Thus, the Final Office Action has not properly ascertained the differences between the prior art and the claimed invention. In view of the reasoning presented

above, Applicants therefore submit that independent claim 1 is also not obvious over *Gunji*, *Nakajima*, and *Lopresti*, whether taken alone or in any combination. Independent claim 1 should therefore be allowable. Therefore, dependent claim 8 is allowable at least by virtue of its dependence from allowable independent claim 1, and because it recites additional features not taught or suggested by the cited references. Accordingly, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of claim 8.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application, withdrawal of the claim rejections, and the timely allowance of the pending claims.

The Final Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Final Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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